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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/685,384 | 10/10/2000 | Lin He | SP00-291 | 4601 |
| 22928 | 7590 | 07/01/2004 | EXAMINER | |
| CORNING INCORPORATED SP-TI-3-1 CORNING, NY 14831 | | | JOHNSON, EDWARD M | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1754 | | |

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/685,384 | HE ET AL. |
| | Examiner | Art Unit |
| | Edward M. Johnson | 1754 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 April 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3-29 and 31-41 is/are pending in the application.
 - 4a) Of the above claim(s) 35-41 is/are withdrawn from consideration.
- 5) Claim(s) 29 and 31-34 is/are allowed.
- 6) Claim(s) 1 and 3-28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-8, 10-12, 14-16, 18, 20, 22-23, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Oliver US 3,915,896.

Regarding claim 1, Oliver '896 discloses a catalyst for exhaust gas treatment of NO_x with NO_x and ammonia at the outlet (see abstract and column 10, lines 10-14) comprising chromia or iron oxide support (see column 1, lines 49-53) impregnated with platinum, rhodium, and/or palladium (see claims 12-13 and Example 1).

Regarding claims 3-4, Oliver '896 discloses 0.001-5% (see column 5, lines 11-20).

Regarding claim 5, Oliver '896 discloses iridium (see column 5, line 16).

Regarding claims 6-8, 10-12, 14-16, 18, 20, 22-23, 25-26, Oliver '896 discloses barium and rare earth metals "can" be present (see column 1, lines 60-64) and the claimed range includes zero.

3. Claims 1 and 3-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Andersen et al. US 6,022,825.

Regarding claim 1, Andersen '825 discloses a NO_x catalyst (see column 1, lines 13-15 and Example 3) comprising a support of iron oxide and/or ceria (see column 4, lines 30-37) impregnated with platinum, palladium, rhodium, or iridium (see column 4, lines 21-29).

Regarding claims 3-4, Andersen '825 discloses 0.72% Pd, and 0.08% Rh (see column 3, lines 59-60).

Regarding claim 5, Andersen '825 discloses 2.2% NiO (see column 8, line 59).

Regarding claims 6-28, Andersen '825 discloses 2-7% lanthanum oxide (see column 2, line 42), barium "may" be present (see column 4, lines 34-37), and all of applicant's claimed ranges include zero.

Allowable Subject Matter

4. Claims 29 and 31-34 are allowed.

5. The following is a statement of reasons for the indication of allowable subject matter: A catalyst comprising the compound of the formula of the instant claim 29 would not have been obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

6. Applicant's arguments filed 4/29/04 have been fully considered but they are not persuasive.

It is argued that applicants respectfully submit that the aforesaid required elements are not set forth in Oliver. This is not persuasive because Applicant appears to admit that the support of Oliver "requires chromia or iron oxide" and Oliver further discloses impregnating with platinum, rhodium, and/or palladium (see claims 12-13 and Example 1).

It is argued that Anderson is directed to a three-way catalyst... innocuous gases. This is not persuasive because conversion to NH₃ is an intended use of the claimed product appearing in the preamble of the claim. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further, Applicant does not claim an "oxygen-rich environment" at all. It is noted that the features upon which applicant relies (i.e., an oxygen-rich environment) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is argued that furthermore, Anderson teaches a catalyst... La-stabilized alumina. This is not persuasive because Anderson discloses an iron oxide support (see above) and Applicant does not claim a catalyst that does not have more than one support. It is noted that the features upon which applicant relies (i.e.,

a catalyst limited to "only" a single support) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward M. Johnson whose telephone number is 571-272-1352. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman can be reached on 571-272-1358. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0987.

EMJ
June 23, 2004



STANLEY S. SILVERMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700